

REMARKS

Claims 22-25 and 27-37 are currently pending to which the Examiner has presented several rejections to which the Applicants respond in the following order:

- I. Claims 22-25 and 27 are rejected under 35 USC § 103(a) as allegedly unpatentable under Gosselin et al.
- II. Claims 28-37 are rejected under 35 USC § 112 ¶ 2 as allegedly being indefinite.
- III. Claims 28-37 are rejected under 35 USC § 112 ¶ 1 as allegedly failing to comply with the written description requirement.

I. Claims 22-25 and 27 Are Not Obvious

The Examiner continues to provide the same rationale to support this rejection by improperly assuming that Gosselin et al. teaches a sterile solution:

Gosselin et al. teach leukotriene LTB₄ in a sterile liquid ...

Final Office Action pg 3, despite the fact that the claims properly recite that the sterile liquid is an aerosol. In regards to this claim element, the Examiner continues to improperly assert that:

While the claims recited that the solution aerosolized ... these phrases are given not patentable weight. See, *Union Oil ... In re Rosicky ... In re Riden ... In re Lerner ...*

Final Office Action, pg 3. The Examiner is reminded that the Board disagrees with this claim interpretation:

The Examiner has interpreted the claim to give the “wherein” clause no patentable weight (Answer 3). ... We disagree with the Examiner’s claim interpretation.

Ex parte Peters-Golden, pg 3, Appeal 2007-1145 (2007). The Board's position clearly establishes that the Applicants' term "aerosol" has patentable weight, and is adequately described and enabled within the Applicants' specification.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 22 to recite "an aerosol comprising a gaseous suspension" and delete the "antibiotic" element. New Claim 38 now provides the aerosol comprising an antibiotic. This amendment has support under the Board's decision accepting the art-accepted definition of "aerosol" defined in the Applicants' Reply Brief:

The Specification's description of administering compositions by aerosolization supports Applicants' position that claim 22 defines a composition in aerosol form or in a form suitable for aerosolization (corresponding to Appellants' two definitions of "aerosol"). The Examiner has not disputed the accuracy of Appellants' definition of "aerosol." We therefore interpret claim 22 to be directed to a composition comprising the recited elements, in a form which is either a gaseous suspension of particles or packaged under pressure with a gaseous propellant.

Ex parte Peters-Golden, pg 3, Appeal 2007-1145 (2007). These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants respectfully request that the Examiner withdraw the Obviousness rejection and pass the claimed embodiment to allowance.

II. Claims 28-37 Are Not Indefinite

The Examiner has improperly ignored the Applicants' claim amendments to Claims 28-37 by suggesting that the Applicants must initiate a second appeal for a decision:

Applicants have amended Claim 28 and 33 to recite that they are claiming an article of manufacture as indicated by the Board. It appears that such amendment overcomes the rejection as intended by the Board, but since the Board made the rejection the Examiner will defer to the Board regarding whether the rejection is maintained or not IF this application is ever referred back to the Board for review. For now, the Examiner will hold this rejection in abeyance, allowing the Board discretion at any further prosecution of this application in the future.

Final Office Action pg 6. The Examiner has not provided any procedural authority for these statements. Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have canceled Claims 28-37 in order to expedite the allowance this application. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Examiner is respectfully requested to withdraw the present rejection.

III. Claims 28-37 Are Adequately Described

The Examiner presents a new rejection in this Final Office Action on the basis of lack of written description. The Applicants believe this rejection is now moot due to the above cancellation of Claims 28-37. The Examiner is respectfully requested to withdraw the present rejection.

CONCLUSION

The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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